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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,239	08/03/2001	Cheryl Steed	4232/2	7541

3000 7590 07/11/2005
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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,239

Applicant(s)

STEED ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 49-61 is/are pending in the application.
- 4a) Of the above claim(s) 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 49-57, and 59-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Claim 58 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 49-57, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (4864740) in view of Ogden (5388349) and/or Cintron (5675914) and Watt (4808458).

Oakley shows an insert comprising a synthetic non woven fabric layer (4), a non slip material (12, or coatings see column 3 lines 60-64), a material layer (10), and a surfactant on the fabric (column 3 lines 14-16) substantially as claimed except for the exact material for the synthetic non-woven fabric layer. Oakley states that the coefficient of friction for the bottom surface (16) of material (12) is greater than 170 (column 3 lines 40-45). Ogden teaches adjusting the coefficient of friction of a synthetic non woven top surface of an insert to above 0.5 (see column 11 lines 50-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the top having a coefficient of friction of between 0.52 and 0.82 which is above 0.5 as suggested by Ogden and within a common range of coefficients of friction

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of commonly used insole materials (such as leathers, synthetic leathers, etc.), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It would have been obvious to provide the top layer with a coefficient of friction of above 0.5 as taught by Ogden in the insert of Oakley to increase the feeling of control of the footwear. Also, Cintron teaches the well known and conventional use of suede materials for the top layers of inserts (column 3 lines 1-2). Watt teaches a specific suede-like material (i.e. fake suede, synthetic suede) which has vertically disposed fibers (18). It would have been obvious to use a suede material as suggested by Cintron and to use the synthetic suede-like material taught by Watt for the nonwoven layer of the insert of Oakley to provide a soft and comfortable feel.

Response to Arguments

4. Applicant's arguments filed 7/28/04 have been fully considered but they are not persuasive.

In response to applicants' argument that the material layer of Ogden is not a synthetic nonwoven, it is noted that in the rejection Oakley has been relied upon to show a layer 4 which is a synthetic non-woven fabric layer, i.e. spunbonded polypropylene fibers and other materials which are clearly considered to be fabrics (see column 2 lines 13-29). Ogden has been applied in the rejection as merely a teaching reference to provide incentive to make the top layer with a particular coefficient of friction. Ogden states that the vinyl acetate content of the thermoplastic material (i.e. the top layer of the insert) is variable to alter the coefficient of friction (column 6 lines 45-

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51) and clearly states that it is desirable to vary the coefficient of friction and teaches a coefficient of friction above 0.5 (column 11 lines 1-57). It would appear that it would have been obvious through discovery of workable ranges by one having routine skill in the art and as suggested by Ogden to merely raise the vinyl acetate content of the layer 20 to obtain a coefficient of friction of between 0.52 and 0.82 which are clearly above 0.5 and which is only a small amount above the 0.5 as suggested by Ogden to provide an enhanced feeling of control (as suggested by Ogden). In response to applicants' argument that there is no incentive to attempt such, Ogden provides clear incentive in stating "Any of the insoles of this invention described above having a higher coefficient of friction permits comparatively lesser sliding movement of the sock therealong to provide an enhanced feeling of control of the article of footwear" (column 11 lines 50-54).

In response to applicants' arguments directed towards Cintron, Cintron has been merely used as a linking reference to show that it is well known and conventional to use suede like materials for the top of footwear inserts and since Oakley states "Other useful embodiments of top layer 4 include meltblown polymers, such as polypropylene, polyester, and nylon; or a composite of meltblown and spunbonded materials" (column 2 lines 26-29), it would clearly be obvious to look to other well known and conventional materials which are in the categories stated. Watt has been applied to show a specific suede like material, i.e. composite of meltblown and spunbonded polymer materials which is a material clearly suggested by Oakley. The material of Watt is clearly synthetic, nylon, polyester, polypropylene, etc. (see column 2 lines 15-20 and 40-50).

Also, since this material is very similar if not the same material disclosed by applicant, i.e. a synthetic suede like material made with the vertical fibers being made from polyester or nylon fibers, the coefficient of friction of this material is considered to be inherently within the ranges claimed.

In response to applicants' argument that the applied references don't have a coefficient on the outer outside surface which is greater than the coefficient on the inside, clearly the extremely high coefficient of friction stated by Oakley of "greater than 170" (column 3 lines 40-45) for the outside surface is definitely higher than the .5 and slightly higher coefficients stated for the inside layer.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 (FORMAL FAXES ONLY). Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728